

REMARKS/ARGUMENTS

Claims 36-38, 40, 42-45, 47-62 and 66-68 are pending, claims 45, 47-49 and 66-68 having been withdrawn from consideration. By this Amendment, claim 36 is amended. Support for the amendments to claim 36 can be found, for example, in the present specification at page 1, lines 22 to 26, page 2, lines 4 to 11, and page 47, lines 19 to 37, and in original claim 36. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Withdrawn Claims

For the reasons set forth below, Applicants submit that all pending claims presently subject to examination are in condition for allowance. Because each of the withdrawn claims depends from, and thus recite all features of, an allowable claim subject to examination, rejoinder and allowance of the withdrawn claims are respectfully requested.

Rejection Under 35 U.S.C. §112, First Paragraph

The Office Action rejects claims 36-38, 40, 42-44 and 50-62 under the written description requirement of 35 U.S.C. §112, first paragraph. Applicants respectfully traverse the rejection.

The Office Action asserts that the recitation in claim 36 of "the tackifying wax has a tack greater than or equal to 0.7 N.s" and the recitation in claim 44 of "the waxes have a hardness of from 0.05 MPa to 3 MPa" are not supported by the specification as filed. In particular, the Office Action asserts that the specification, while describing specific waxes (e.g., Kester Wax K 82 P, Kesterr Wax K 80 P) having the recited properties, such description does not support the entire genus of tackifying waxes having such properties. *See* Office Action, pages 3 to 5. Applicants respectfully disagree.

The Office Action identifies a list of 19 "tacky waxes" and asserts that the present specification does not describe such waxes. *See* Office Action, pages 3 to 5. The list appears to be derived from the list at column 5, lines 58 to 65, of the Brieva reference (discussed below), which does not indicate that the recited waxes are tackifying waxes.

The present claims do not merely require "tackifying" waxes, but rather require waxes having particular tack and hardness values. The present specification provides detailed protocols for determining tack values and hardness values for a particular wax. *See* present specification, pages 29 to 31. One of ordinary skill in the art, at the time the present application was filed, would readily be able to determine the tack and hardness values for a wax (and thus whether a wax falls within or outside the scope of the claims) using such protocols.

While the present specification includes a limited number of examples of specific waxes (*see, e.g.*, present page 9), one of ordinary skill in the art, using his own knowledge or the additional guidance provided in the present specification could identify tackifying waxes as recited in the present claims (i.e., having specific tack and hardness values). For example, tack and hardness values for many waxes can be readily discerned from literature. If the tack and hardness values for a particular wax cannot be readily discerned from literature, such values can be identified from the protocols in the present specification. As discussed in MPEP §2163, "[t]he written description requirement for a claimed genus may be satisfied ... by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties ..." (emphasis added). Applicants have, in the present case, defined the claimed subject matter using physical properties that are well-understood by those of ordinary skill in the art.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that

the inventor had possession of the claimed invention. *See* MPEP §2163. The Office Action fails to provide an adequate basis for why a skilled artisan would conclude that the present inventors were not in possession of the claimed invention when the present application was filed.

For the foregoing reasons, claims 36-38, 40, 42-44 and 50-62 are fully supported by the specification as filed. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §103

The Office Action rejects claims 36-38, 40, 42-44 and 50-62 under 35 U.S.C. §103(a) over U.S. Patent No. 5,985,298 to Brieva et al. ("Brieva") in view of U.S. Patent No. 5,783,176 to Meiring et al. ("Meiring"). Applicants respectfully traverse the rejection.

Claim 36 recites "[a] composition, comprising: at least one fatty phase comprising at least one structuring agent; wherein: the structuring agent is selected from the group consisting of tackifying waxes, combinations of at least one specific compound with at least one oil, and mixtures thereof; the at least one specific compound is selected from the group consisting of semi-crystalline polymers, fatty-phase rheological agents and mixtures thereof; the tackifying wax has a tack greater than or equal to 0.7 N.s; the composition is in the form of an emulsion; the composition has a solids content defined by a dry solids extract of more than 47% by weight; the composition has a consistency index of less than 1 000 Pa; and the composition is in the form of mascara" (emphasis added). Brieva and Meiring do not disclose or suggest such a composition.

As indicated above, claim 36 requires a mascara composition that is in the form of an emulsion and includes a wax having a tack greater than or equal to 0.7 N.s. Brieva discloses a single example (Example 2) of a mascara composition. *See* column 7, line 56 to column 8,

line 19. The mascara composition does not include a wax having a tack greater than or equal to 0.7 N.s. In addition, the mascara composition of Brieva does not include a surfactant – the composition is not in the form of an emulsion.

Meiring does not remedy the deficiencies of Brieva. The Office Action relies on Meiring for its disclosure of a tackifying wax. *See* Office Action, pages 5 to 6. However, Meiring is directed to compositions for lip care, and particularly lipsticks. *See, e.g., Meiring*, column 1, line 42 to column 3, line 22. Meiring does not include a single example of a mascara composition, much less a mascara composition in the form of an emulsion as required in claim 36. Neither reference discloses or suggests a mascara composition in the form of an emulsion.

Moreover, the compositions of the examples of Meiring that include synthetic beeswax are stick formulations – not a mascara composition as in Brieva, or mascara compositions in the form of emulsions as required in claim 36. One of ordinary skill in the art would not have reasonably expected that the teachings of Meiring, relating to waxes that are useful in preparing lipsticks would have any usefulness in a composition having an entirely different form and which presents entirely different technical (e.g., structural) requirements, i.e., the mascara composition of Brieva or, still further afield, a mascara composition in the form of an emulsion as recited in claim 36. As is well-settled, a *prima facie* case of obviousness based on a proposed modification to a reference (e.g., adding a wax from a lipstick of Meiring to the mascara of Brieva) will only stand if one of ordinary skill would have had a reasonable expectation of success upon making the modification. *See, e.g.,* MPEP §2143.02 (citing *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986)). One of ordinary skill in the art would have had no reason to expect that the waxes of the lipstick compositions of Meiring could appropriately function in the mascara composition of Brieva.

The composition of claim 36 is a mascara composition that is in the form of an emulsion and includes a wax having a tack greater than or equal to 0.7 N.s. These features unexpectedly and surprisingly (particularly in view of the high tack value of the recited wax) allow for the high solids content and low consistency recited in claim 36. Breiva and Meiring do not disclose or suggest the particular combination of features recited in claim 36, or recognize the benefits stemming therefrom.

As explained, claim 36 would not have been rendered obvious by Breiva and Meiring. Claims 37, 38, 40, 42-44 and 50-62 depend from claim 36 and, thus, also would not have been rendered obvious by Breiva and Meiring. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Double Patenting

A. 887 Application

The Office Action provisionally rejects claims 36-38, 40, 42-44 and 50-62 under the judicially created doctrine of obviousness-type double patenting over claims 1-21, 73-91 and 96 of U.S. Patent Application No. 10/654,887. Applicants respectfully traverse the rejection.

Claim 36 of the present application requires a mascara composition in the form of an emulsion. None of claims 1-21, 73-91 and 96 of the 887 application recites or suggests a mascara composition in the form of an emulsion. Accordingly, claim 36 of the present application is not obvious over claims 1-21, 73-91 and 96 of the 887 application. Claims 37, 38, 40, 42-44 and 50-62 of the present application depend from claim 36 and, thus, also are not obvious over claims 1-20, 79-96 and 102-107 of the 907 application. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Applicants also submit that it may be appropriate to withdraw the provisional rejection when the present application is otherwise in condition for allowance, pursuant to

MPEP §§ 804, 822.01. When a determination is made as to whether the provisional rejection is to be withdrawn, Applicants will file a Terminal Disclaimer or take other appropriate action, if necessary.

B. 907 Application

The Office Action provisionally rejects claims 36-38, 40, 42-44 and 50-62 under the judicially created doctrine of obviousness-type double patenting over claims 1-20, 79-96 and 102-107 of U.S. Patent Application No. 10/654,907. Applicants respectfully traverse the rejection.

Claim 36 of the present application requires a mascara composition in the form of an emulsion. None of claims 1-20, 79-96 and 102-107 of the 907 application recites or suggests a mascara composition in the form of an emulsion. Accordingly, claim 36 of the present application is not obvious over claims 1-20, 79-96 and 102-107 of the 907 application. Claims 37, 38, 40, 42-44 and 50-62 of the present application depend from claim 36 and, thus, also are not obvious over claims 1-20, 79-96 and 102-107 of the 907 application. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Applicants also submit that it may be appropriate to withdraw the provisional rejection when the present application is otherwise in condition for allowance, pursuant to MPEP §§ 804, 822.01. When a determination is made as to whether the provisional rejection is to be withdrawn, Applicants will file a Terminal Disclaimer or take other appropriate action, if necessary.

Application No. 10/656,201
Reply to Office Action of February 10, 2009 and
PTO Communication of December 3, 2009

Conclusion

For the foregoing reasons, Applicants submit that claims 36-38, 40, 42-45, 47-62 and 66-68 are in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

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